

REMARKS

The Office Action of March 20, 2005 presents the examination of claims 35-54. The present paper amends claims 35, 50 and 54. Claims 35-54 remain pending.

Substance of Interview

A telephone interview was conducted with the Examiner on February 22, 2005. The Summary of the Interview attached to the present Office Action substantially reflects the substance of the interview.

In addition to the items expressly mentioned in the Summary of the Interview, it was discussed that a "Lundak" Declaration in support of a deposit of a bacterium harboring the pTOK162 should be filed.

Rejections under 35 U.S.C. § 112, first paragraph

Claims 35-54 stand rejected under 35 U.S.C. § 112, first paragraph, for alleged lack of enablement of a method for transformation of monocot plants that comprises incubation of plant tissue for "an unspecified duration on an auxin-containing medium". The Examiner relies essentially upon the unpredictability of the art of plant transformation by *Agrobacterium* to assert that a period of time of the culturing step i) of the instant claims should conform to the time described expressly in the specification, i.e. a period of from 1 to 6 days. Claims 35, 50 and 54 are so amended, and thus the instant rejection is believed to be overcome. Applicants note the Examiner's conclusion of the Office Action that amendment of the claims in the manner above would obviate all rejections and result in allowance of the application.

Claims 43 and 49 stand rejected under 35 U.S.C. § 112, first paragraph, for alleged lack of evidence that the plasmid pTOK162 can be reproducibly obtained by one of ordinary skill in the art. The Examiner requires that evidence of a deposit of biological material constituting the plasmid pTOK162.

Accordingly, Applicants provide attached hereto a “Lundak” declaration that attests to deposit of a bacterial strain harboring the plasmid pTOK162 and that provides assurances that all restrictions on availability of the plasmid will be removed upon issuance of a U.S. Patent from this application.

The specification is amended to recite the description of the deposit. MPEP 2406.01.

Thus, the instant rejection should be withdrawn.

Rejection over prior art

Claims 35, 36, 40-42, 44, 46, 50-52 and 54 remain rejected under 35 U.S.C. § 102(a) as anticipated by Dale et al. The Examiner indicates that Dale et al. describes transformation of monocot plant cells (wheat) using *Agrobacterium*, by co-culture of the plant tissue with the *Agrobacterium* in a medium comprising an auxin (2,4-D). The Examiner notes that the method of Dale et al. constitutes “instantaneous preculture.”

Claims 35, 50 and 54 are amended above in the manner suggested by the Examiner to obviate all rejections and result in allowance of the claims. Accordingly, it is believed that the instant rejection is overcome.

Obviousness-type double patenting

Claims 35-54 are rejected under the judicially-created doctrine of obviousness-type double patenting over claims 1-25 of U.S. Patent 5,591,616. Applicants address this rejection by submitting attached hereto a Terminal Disclaimer.

The present application well-describes and claims patentable subject matter. The favorable action of allowance of the pending claims and passage of the application to issue is respectfully requested.

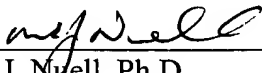
Application No.: 09/229,324

Docket No.: 0760-0262P

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Mark J. Nuell (Reg. No. 36,623) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Dated: August 3, 2005

Respectfully submitted,

By  _____
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Attachments: Declaration regarding Deposit of Microorganisms
Terminal Disclaimer